

REMARKS/ARGUMENTS

Claims 34-69 are active in this application.

Claim 37 is amended for clarity and is believed to address the issue raised under 35 USC § 112, second paragraph.

No new matter is added.

The claimed invention as set forth in Claim 34 (Appendix I) is directed to a cosmetic composition comprising an aqueous phase with at least one compound with an optical effect and a polymer comprising

- (1) water-soluble units bearing before reaction at least two reactive sites
- (2) LCTS units, bearing before reaction at least one reactive site, consisting of N-vinylcaprolactam homopolymers or copolymers in a proportion by weight from 5 to 70%
- (3) wherein the polymer is a block polymer comprising water-soluble blocks alternating with LCST blocks or the polymer is a graft polymer whose backbone is formed from water-soluble units and bears LCST grafts

As set forth in the specification on page 2, lines 19-26, the aim of the present invention is to satisfy:

The need for a composition with an optical effect, which gives, after application deposits or films with excellent staying power even under humid and/or hot atmospheric conditions. The said composition that can provide a wide range of textures, in particular at room temperature, allows an easy application.

The prior art cited in the Office Action does not describe, with sufficient specificity, the selection of monomers of a polymer in a cosmetic composition where the polymer is (a) a block polymer comprising water-soluble blocks alternating with LCST blocks; OR (b) a graft polymer whose backbone is formed from water-soluble units and bears LCST grafts.

In the Official Action, the rejection of all claims in view of the Torgerson patent has been maintained for essentially the same reasons as before. The Examiner's rationale is that from amongst the vast number of possible combinations of the A and B monomers one would have chosen the types of monomers included within the scope of the claims. However, notably, absent from the Examiner's rejection is a lack of discussion (because there is none in Torgerson) to specifically arrange these monomers as a block or graft polymer as defined in the claims.

Specifically, there is nothing in Torgerson which provides one the requisite direction to (1) select from the vast number of disclosed monomers to form the units of the claims and (2) from all of the possible structures to select a block polymer comprising water-soluble blocks alternating with LCST blocks or the polymer is a graft polymer whose backbone is formed from water-soluble units and bears LCST grafts. Indeed, there is nothing in Torgerson which directs one to make these two selections so that the problems with prior cosmetic compositions could be solved (see above) such that the copolymer can control the rheology of aqueous solutions as a function of temperature while maintaining transparency of the compositions (see pages 4-5 of the present specification).

As discussed at length in the Appeal Brief filed prior to this new Office Action, the first option in Claim 34, which is defined as a block copolymer with alternating units of water-soluble and LCST blocks, is clearly different than the grafted polymers described by Torgerson. Therefore, even if one could simply pick and choose the appropriate monomers, the monomers would not be arranged as in the present claims following the description in Torgerson. Concerning the second option in Claim 34, which is defined as a water-soluble backbone with LCST grafts, this polymer is certainly not described in Torgerson.

The definition of Torgerson's copolymer is found in col. 2 in which the copolymer is defined as a water or alcohol soluble thermoplastic elastomer having a backbone and two or more side chains (a.k.a. grafts). There is no disclosure for a block copolymer as claimed. Torgerson's copolymer (which has a backbone with pendant side chains) is described as being formed from copolymerization of randomly repeating A and B units. The A and B units are defined in col. 3, lines 1-47 and if one were to copolymerize the A and B units in the manner as explicitly described by Torgerson the resultant copolymer would have a backbone (main chain) of A units and from some E moieties copolymerized with A, these A and E units randomly distributed in the backbone. Such would not result in block copolymer as claimed. In col. 3, line 20, Torgerson describes that the B units are for the side pendant chains.

The graft polymers whose backbone is formed from water-soluble units and bears LCST grafts as defined in the claims of the present application are completely different from those in Torgerson. Specifically, Torgerson describes the graft copolymers as:

characterized in having an elastomeric or flexible backbone and rigid, thermoplastic, hydrophilic side chains. (col. 4, lines 55-56)

Therefore, unlike the graft polymers defined in the claims (having a water-soluble backbone) the Torgerson polymers have hydrophilic (i.e., water-soluble) side chains.

As one basis for supporting the rejection the Examiner stated : "the implication of claims 47 and 49 is that in some embodiments, the LCST can be the water-soluble unit and the water soluble unit can be the LCST." (Page 4 of the Official Action). However, this rationale is misplaced as both claims define "LCST" units.

Thus, regardless of what the A and B monomers describe what is very clear is that even if one could pick a choose various monomers that could be considered waters-soluble or LCST units, Torgerson's implied and explicit descriptions lead one to completely different

polymers than the polymers defined in the claims. In view of these distinctions, Applicants request withdrawal of the rejection under 35 USC 102(b) in view of Torgerson.

The new rejection in the Official Action alleges that Claims 34 and 41 are anticipated by US Patent No. 5,412,035 (Schmitt). The Schmitt patent describes adjusting the effect of a pressure sensitive adhesive (PSA) with crystalline additives (see column 1, lines 31-40). As discussed in col. 1, PSA composites often leave adhesive residue, and, in the medical field, this residue can be quite problematic. To solve this problem, the crystalline additive is employed.

Schmitt also describes number of known PSA's (see column 11, line 19 through column 12, line 30) combined with additives specifically selected "to the intended use of the PSA" (see column 12, lines 50-51). Schmitt further describes that the additive polymers can contain a number of groups (see column 13, line 4 through column 14, line 64) and identify that preferred polymers are those with side chains attached to a backbone, the side chains imparting crystallinity (see column 13, lines 5-9). By picking and choosing certain monomers listed in Claim 11 of Schmitt (see column 29), the Examiner contends that this reference describes the same polymers as being claimed in the pending application. Here again, however, the Examiner has failed to point out (because the reference fails to describe) arranging the monomers as required in the claims.

In fact, the description in Schmidt does not lead one to the types of copolymers defined in the pending claims. In col. 13, lines 4-7, Schmitt describes that the preferred additives are "crystalline polymers in which the crystallinity results exclusively or predominantly from side chains which are attached to the polymer backbone. Such polymers are often referred to as Side Chain Crystallizable polymes ("SSC")." Types of SSC are listed

in col. 13, line 23 through col. 14, line 16 and are those with crystallizable Cy which are aliphatic or aromatic. These moieties do not exhibit any LCST.

In col. 14, line 65 through col. 15, line 6, Schmitt describes that the PSA's chosen must be of the type having good vapor transmission rate and can include in the backbone, the side chain or both, recurring units derived from a hydrophilic comonomer such as acrylic acid. These polymers also not contain any units with an LCST.

There is nothing in Schmitt which directs one to make a selection of certain units AND arrange the units in the specific manner as claimed (i.e. a block polymer comprising water-soluble blocks alternating with LCST blocks or the polymer is a graft polymer whose backbone is formed from water-soluble units and bears LCST grafts). In fact, there is nothing in Schmitt which would lead to address the problems with prior cosmetic compositions such that the copolymer can control the rheology of aqueous solutions as a function of temperature while maintaining transparency of the compositions (see pages 4-5 of the present specification) because the Schmitt polymers are chosen specifically to solve problems with using Pressure sensitive adhesives that are typically applied to, e.g., a piece of paper to facilitate sticking to a surface.

In view of these distinctions, Applicants request withdrawal of the rejection under 35 USC 102(b) in view of Schmitt.

As for the provisional rejection under the doctrine of obviousness-type double patenting, Applicants request that the rejection be held in abeyance since the alleged conflicting claims have not yet been patented (see MPEP § 822.01).

Application No. 10/070,911
Reply to Office Action of March 15, 2006

After reconsideration of the rejections in view of the above discussion, Applicants
request a Notice of Allowance for all pending claims.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Registration No. 36,379

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Daniel J. Pereira, Ph.D.
Registration No. 45,518